

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR C. FITZGERALD, JOHN F. COUGHLAN
and JACK B. GOLDMAN

Appeal No. 2004-0348
Application No. 09/901,220

ON BRIEF

Before KIMLIN, DELMENDO and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 54-56 and 59-65. Claims 54 and 65 are illustrative:

54. A method of manufacturing document storage containers for storing documents, comprising the steps:

die cutting a blank document container from document container stock;

embedding a radio frequency identification tag in the document container stock; and

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folding and gluing the document container to form a completed document storage container.

65. A method of manufacturing document storage containers for storing documents, as recited in claim 54, wherein the step of embedding includes the steps of:

depositing a radio frequency identification tag on the document container stock in proximity to a seam;

applying glue to the area of the seam;

folding and gluing the seam to capture the radio frequency identification tag within the glued portion of the seam.

The examiner relies upon the following references as evidence of obviousness:

Feiler	5,159,180	Oct. 27, 1992
Gillotte	5,424,858	Jun. 13, 1995
Wiholm	6,186,935	Feb. 13, 2001

Appellants' claimed invention is directed to a method of making containers for storing documents, such as medical records. The method entails die cutting material for the container from document container stock, embedding a radio frequency identification tag (RFID) in the container stock, and folding and gluing the container stock to form a completed document storage container. Claim 65 on appeal further provides for depositing the RFID in proximity to a seam of the container, applying glue to the seam, and "folding and gluing the seam to capture the radio frequency identification tag within the glued portion of the seam." According to appellants, "[t]he RFID tags which are

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recited in the present claims are of a known structure, which is described in the present specification as filed . . ." (page 2 of Brief, last paragraph).

Appealed claims 54 and 59-65 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wiholm in view of Gillotte. Claims 55 and 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over the stated combination of references in further view of Feiler.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. As a result, with the exception of appealed claim 65, we find that the examiner has established a prima facie case of obviousness for the claimed subject matter which has not been adequately rebutted by appellants. Accordingly, we will sustain the examiner's rejection of claims 54-56 and 59-64, but we will not sustain the examiner's rejection of claim 65.

Appellants do not make the argument that it would have been nonobvious for one of ordinary skill in the art to modify the folder of Wiholm by incorporating the electromagnetic receiver 20 of Gillotte. Rather, it is appellants' contention that Wiholm does not disclose "a document storage container or file folder in the conventional sense; that is, a container for holding a loose

collection of papers and documents,"¹ but, rather, the reference discloses a book binding method and apparatus. However, we agree with the examiner that appellants' argument is not commensurate in scope with the breadth of subject matter encompassed by claim 54. Claim 54 on appeal does not define a storage container or file folder which holds a loose collection of papers and documents, but broadly embraces "document storage containers for storing documents." Hence, although Wiholm permanently attaches the individual sheets or documents into the folder with hot-melt glue at the spine of the folder, appealed claim 54 fails to recite any limitation which distinguishes over the permanently attached documents in the folder of Wiholm.

Appellants also maintain that "[t]he Wiholm reference does not include any folded seams or glued folded seams in which a radio frequency identification tag may be **embedded in the document container stock** as claimed in the present claim 54."² However, as explained by the examiner, appellants' argument is not germane to the subject matter defined by claim 54. Claim 54 does not require that the RFID tag be embedded in a folded seam, but only requires that the RFID tag be embedded somewhere in the

¹ Page 5 of Brief, last paragraph.

² Page 6 of Brief, third paragraph.

document container stock. On this point, we agree with the examiner that Gillotte discloses, or at least suggests, embedding an RFID tag in some area on the folder. While the identification receiver 20 of Gillotte may not be identical to the identification tag used by appellants, we find that it would have been obvious for one of ordinary skill in the art to employ the admittedly known RFID tag disclosed by appellants.

As for separately argued claim 62, we agree with the examiner that Wiholm discloses such a reinforced double-sided file folder to the extent that the folder, by definition, includes two sides. As for claim 63, we find that labeling the container a "file box" fails to distinguish the claimed subject matter over the file folder of Wiholm. We also concur with the examiner that it would have been obvious for one of ordinary skill in the art to modify the folder of Wiholm in order to hold removable x-ray film. As noted by the examiner, Gillotte evidences that it was known in the art to use file folders to store x-ray films and we are persuaded that it would have been obvious for one of ordinary skill in the art to eliminate the gluing taught by Wiholm when permanently securing the documents is not desirable. It is well settled that it is a matter of

prima facie obviousness for one of ordinary skill in the art to eliminate a feature of the prior art along with its advantage.

Concerning separately rejected claims 55 and 56 which call for printing identification information received from a computer database on the document container stock for storing medical-related records, we are in complete agreement with the examiner that such a printing of information on a file folder was notoriously well-known in the art at the time of filing the present application and, accordingly, such printing would have been obvious to one of ordinary skill in the art.

The rejection of claim 65 is another matter. Claim 65 specifically requires "folding and gluing the seam to capture the radio frequency identification tag within the glued portion of the seam." While the examiner focuses upon the claimed step of depositing the tag "in proximity to a seam," and argues that "the tag could be located next to the seam not exactly on the seam as been argued,"³ claim 65 nevertheless requires that the folding and gluing steps result in the tag being captured within the glued portion of the seam.

³ Page 4 of Answer, last sentence.

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As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing, the examiner's rejections of claims 54-56 and 59-64 are sustained, whereas the examiner's rejection of claim 65 is reversed. Accordingly, the examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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ROMULO H. DELMENDO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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BEVERLY PAWLIKOWSKI)	
Administrative Patent Judge)	

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